

REMARKS¹

In the outstanding Office Action, the Examiner rejected claims 1-50, 52-60, and 62-69 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,359,849 to Sato et al. ("Sato") in view of U.S. Patent No. 6,061,793 to Tewfik ("Tewfik"); and rejected claims 1-50, 52-60, and 62-69 under 35 U.S.C. § 102(e) as being anticipated by Tewfik. No claims are amended herein. Claims 1-50, 52-60, and 62-69 remain pending in this application.

I. Rejection under 35 U.S.C. § 102(e)

Applicant respectfully traverses the rejection of claims 1-50, 52-60, and 62-69 under 35 U.S.C. § 102(e) for at least the reason that Tewfik fails to anticipate claims 1-50, 52-60, and 62-69. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference ... [t]he identical invention must be shown in as complete detail as is contained in the . . . claim." MPEP § 2131 8th Ed. (Rev. 4), October, 2005 (internal citations omitted). Tewfik cannot anticipate claims 1-50, 52-60, and 62-69 because Tewfik fails to teach each and every element recited in claims 1-50, 52-60, and 62-69.

Independent claims 1, 25, 50, and 60 recite a combination including at least "damping and shifting a predetermined number of orthogonal transform coefficients selected from the plurality of orthogonal transform coefficients in the direction of the frequency axis." Tewfik, as originally acknowledged by the Examiner at page 5 of the

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement of characterization in the Office Action.

Office Action mailed December 15, 2005, fails to disclose at least this feature. Tewfik discloses:

the resulting masked watermark is scaled by scale factor 44, and then in step 46 is scaled by the audio signal as each segment thereof has been weighted with a Hanning window in step 36 and as has then been extracted by an extract envelope in step 48. The resulting scaled masked watermark is in step 50 added to the audio signal . . . (col. 8, lines 59-64);

and

[t]he time-domain weighting operation attenuates the energy of the computed watermark (col. 9, lines 1-2).

To the extent that Tewfik's disclosed "scal[ing]" and "weighting" operations can be reasonably considered to correspond to Applicant's claimed "damping and shifting," as recited in claims 1, 25, 50, and 60, Applicant notes that Tewfik does not disclose that either the scaling or weighting operations scale or weight "a predetermined number of orthogonal transform coefficients selected from the plurality of orthogonal transform coefficients," as also recited in claims 1, 25, 50, and 60. That is, Tewfik does not disclose that "a predetermined number of orthogonal transform coefficients," are "selected," and thus cannot provide a disclosure of "damping and shifting" these selected coefficients.

Moreover, again to the extent that Tewfik's disclosed "scal[ing]" operation can be reasonably considered to correspond to Applicant's claimed "shifting," Tewfik does not disclose how the resulting masked watermark is scaled, or what the scale factor is. See Tewfik, col. 8, lines 59-64. Tewfik is thus silent as to "shifting . . . in the direction of the frequency axis," as also recited in claims 1, 25, 50, and 60 (emphasis added).

For at least the foregoing reasons, Tewfik fails to teach each and every feature recited in independent claims 1, 25, 50, and 60. Claims 1, 25, 50, and 60 are thus allowable over Tewfik, and claims 2-24, 26-49, 52-59, and 62-69 are allowable at least due to their dependence from claims 1, 25, 50, and 60. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-50, 52-60, and 62-69 under 35 U.S.C. § 102(e).

II. Double Patenting Rejection

Applicant respectfully traverses the rejection of claims 1-50, 52-60, and 62-69 under the judicially created doctrine of obviousness-type double patenting, on the ground that claims 1-50, 52-60, and 62-69 are not merely an obvious variation of claims 1-26 of Sato.

Independent claims 1, 25, 50, and 60 recite a combination including at least “damping and shifting a predetermined number of orthogonal transform coefficients selected from the plurality of orthogonal transform coefficients in the direction of the frequency axis.” Sato does not recite at least this feature, and at page 3 of the Office Action, the Examiner acknowledges that Sato “does not specifically claim damping and shifting.” To attempt to cure the deficiency of Sato, the Examiner cites Tewfik. Office Action, page 3. As discussed above, however, Tewfik fails to teach or suggest at least “damping and shifting a predetermined number of orthogonal transform coefficients selected from the plurality of orthogonal transform coefficients in the direction of the frequency axis,” as recited in independent claims 1, 25, 50, and 60, and required by dependent claims 2-24, 26-49, 52-59, and 62-69. Tewfik thus cannot be relied upon for curing the noted deficiency of Sato.

Because Sato does not recite or suggest at least this feature, and Tewfik also does not disclose this feature, claims 1, 25, 50, and 60, and all claims that depend therefrom, are not obvious variants of claims 1-26 of Sato. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-50, 52-60, and 62-69 on the ground of nonstatutory obviousness-type double patenting.


In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 3, 2006

By 
Darrell D. Kinder, Jr.
Reg. No. 57,460